



**PRE-APPEAL BRIEF REQUEST
FOR REVIEW**

Application Number	09/328,749
Filing Date	June 9, 1999
First Named Inventor	Gebhard
Atty Docket Number	ADI-005
Art Unit	3728
Examiner	Stashick, A.D.

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

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Applicant requests review of the non-final rejection in the above-identified application pursuant to 37 C.F.R. § 41.50(b)(1). No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record

Registration number 51,842

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

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Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Gebhard **CONF. NO.:** 7235
SERIAL NUMBER: 09/328,749 **ART UNIT:** 3728
U. S. FILING DATE: June 9, 1999 **EXAMINER:** Stashick, A. D.
TITLE: Torsion System for an Article of Footwear

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

This paper is submitted in accordance with the Official Gazette Notice dated July 12, 2005, and a Notice of Appeal, in response to the Office action, mailed by the U.S. Patent and Trademark Office on February 14, 2006 (hereinafter "Office action"). A fee for filing of the Notice of Appeal is submitted herewith, along with the fee for a three-month extension of time. Applicant believes that no other fee is required for this submission to be entered. However, please consider this a conditional authorization to charge any related fees necessary for entry of this submission to Deposit Account No. 07-1700.

Applicant notes that this paper is submitted to "Mail Stop AF," even though review is herein requested from an action that is non-final. 37 C.F. R. § 41.50(b)(1) provides that, when the Board of Patent Appeals and Inferences ("the Board") reverses an Examiner on Appeal and issues a new ground of rejection pursuant to 37 C.F. R. § 41.50(b), the Appellant may amend the claims to overcome the new ground of rejection. Should the Examiner still maintain the Board's rejection, the Appellant may again appeal. Accordingly, Applicant submits that this Request is proper and submits this paper to "Mail Stop AF" in accordance with the Official Gazette Notice dated July 12, 2005.

Applicant's **Remarks** begin on page 2 of this paper.

REMARKS

Applicant appealed from a final Office action issued on January 24, 2003, in which the Examiner rejected claims 1-4, 6-21, and 23-26 as unpatentable in view of various combinations of references.¹ On Appeal, the Board reversed the Examiner's rejections on all counts. *Ex parte Gebhard*, Decision on Appeal, Appeal No. 2005-2544, at 9 (October 31, 2005) (hereinafter "Decision"). Pursuant to its authority under 37 C.F.R. § 41.50(b), the Board entered a new ground of rejection, rejecting only claims 1, 9, 15, 20, and 26 as anticipated by U.S. Patent No. 4,922,631 to Anderie (hereinafter "Anderie"). *Id.* Applicant filed an Amendment and Response under 37 C.F.R. § 41.50(b)(1) on December 21, 2005, amending the claims and presenting arguments to overcome the Board's new ground of rejection based on the interpretation of the claims described in the Decision. In the Office action, the Examiner maintained the Board's rejection of the claims, and issued new rejections of claims 2-4, 6-8, 10-14, 16-19, 21, and 23-25, in view of Anderie and other references already considered by the Board. Applicant respectfully submits the following:

- Anderie does not teach or suggest a torsion system comprising, *inter alia*, "a rib that projects beyond a bottom most surface of the torsion system," as claimed in claim 1;
- Anderie does not teach or suggest a torsion system comprising, *inter alia*, a "rib [that] tunes torsionability of [a] cycling shoe," as claimed in claim 26;
- The Examiner's new rejections of claims 2-4, 6-8, 10-14, 16-19, 21, and 23-25 in view of references already considered by the Board is procedurally improper;
- Anderie does not anticipate claims 6, 8, 10-13, 17, 21, and 24; and
- There is no motivation to modify Anderie, or combine Anderie with any other reference already considered by the Board; therefore, claims 2-4, 7, 11-14, 16, 18, 19, 23, and 25 are not obvious.

1. The Board determined that Anderie describes a torsion system that includes an intermediate sole member 101 and a stiffening element 109, the stiffening element 109 including a rib, e.g., 114, 115, or 116, projecting beyond an adjacent surface, e.g., 113, 118, or 119, of the torsion system. Decision at 10. The Board noted that appealed claim 1 only required that the rib project beyond *some adjacent surface* of the torsion system. *Id.* at 11. Accordingly, in the subsequent Amendment and Response, Applicant amended claim 1 to require that the rib

¹ Claim 6 was not at issue on appeal. Claims 5 and 22 have been cancelled. Decision at 1.

“project[] beyond *a bottom most surface* of the torsion system.” Applicant respectfully submits that the “bottom most surface of the torsion system” of Anderie is the interface between the intermediate surface 101 and the outsole 102. *See* Anderie, FIG. 10. As noted in the Amendment and Response, and as apparent in FIG. 10, Anderie does not teach or describe a rib that projects beyond this surface. Indeed, *no portion* of the stiffening element 109, let alone a rib, projects beyond a bottom most surface of the torsion system of Anderie.

The Examiner’s position that “[t]he ribs of section 109 . . . would project beyond, i.e., *above*, the bottom most surface of 101” is incorrect and extends beyond any reasonable definition of the term “project beyond.” Office action at 4 (emphasis added). The entirety of the stiffening element 109 is completely contained within the intermediate sole member 101, and the Examiner’s position that a location “beyond the bottom most surface of the torsion system” can encompass a location entirely above the bottom surface is absurd. Applicant has defined a “bottom most surface of the torsion system” and claimed a rib that “projects beyond” this surface. Accordingly, a rib that “projects beyond” the recited “bottom most surface” would clearly project *below* the surface, not above the surface, as the Examiner has asserted. In fact, by the Examiner’s definition, a foot contained within a shoe can be said to “project beyond the bottom most surface of the shoe,” merely because the foot is *above* the bottom most surface. This interpretation is clearly wrong and can not stand.

2. In the Amendment and Response, Applicant amended claim 26 to recite the subject matter of claim 6, which recites a “rib [that] tunes torsionability of [a] cycling shoe.” The Examiner has indicated that Anderie anticipates this limitation, but only cites for support a reference in the specification to manufacturing details of the stiffening element of Anderie. *See* Office action at 4. As the Examiner’s citation is not directed to tuning of torsionability by the rib, Applicant submits that amended claim 26 is not anticipated by Anderie.

3. In its Decision, the Board overturned every rejection that the Examiner made in the final Office action, and issued a new ground of rejection in accordance with 37 C.F.R. § 41.50(b). Decision at 9. Applicant, in turn, amended the claims to overcome the rejection. The Examiner, in the subsequent Office action, should only have addressed the claims rejected by the Board and was not entitled to make new grounds of rejection *on references already considered on appeal*. The Manual of Patent Examining Procedure is clear: the Examiner may only make new rejections “if the examiner has specific knowledge of *a particular reference or references* which

indicate nonpatentability of any of the appealed claims as to which the examiner was reversed.” MPEP § 1214.04 (emphasis added).

The Examiner asserts that “the Board decision did not reverse the examiner on the combination of references used with respect to Anderie only,” Office action at 2, implying that this “inaction” provides justification for his new rejections based on different combinations of the same references. This position contradicts the plain language of the MPEP. The MPEP does not indicate that the Examiner may issue a new ground of rejection based on new combinations of references *already considered* by the Board on appeal. The Board reversed the Examiner on all counts and issued a new ground of rejection for only five claims. The procedures are clear: in the face of the Board’s complete reversal of the Examiner and issuance of a new ground of rejection, the Examiner may raise additional grounds of rejection only “if the examiner has specific knowledge of *a particular reference or references* which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed.” A new ground of rejection by the Board does not grant the Examiner *carte blanche* to mix-and-match references already considered by the Board to obtain new grounds of rejection.² The Examiner has identified no new reference or references, therefore, the new rejections of claims 2-4, 6-8, 10-14, 16-19, 21, and 23-25 should be withdrawn.

4. Even if the rejections of claims 6, 8, 10-13, 17, 21, and 24 stand, which they can not, Applicant respectfully submits that Anderie does not anticipate these claims. Applicant directs the panel’s attention to the Decision at p. 9, where the Board identifies only claims 1, 9, 15, 20, and 26 as anticipated by Anderie. Had the Board determined that Anderie alone rendered any other claims anticipated, it would have rejected those claims as well.³ With his “new” rejections, the Examiner has merely applied Anderie *alone* to claims where his rejections based on the combination of Anderie, Dubner, and Kraeuter were overturned. In the most egregious example, the Examiner has rejected independent claim 21 in view of Anderie. The Board specifically noted “the recognized special characteristics of a ‘cycling shoe,’” and flatly rejected the Examiner’s contention that any shoe used to pedal a bicycle can be a “cycling shoe.” Decision at 8. None of Anderie, Dubner, and Kraeuter disclose a cycling shoe. Nevertheless, the Examiner

² Applicant also notes the MPEP’s admonition against performing new searches in the face of a complete reversal to uncover new or better references. MPEP 1214.04.

³ Any assumption to the contrary compels the presumption that the Board only selected claims 1, 9, 15, 20, and 26 at random, and did not consider whether Anderie would anticipate any other claims. This is clearly untenable.

issued a “new” rejection of claim 21 in view of Anderie alone, clearly ignoring the “recognized special characteristics of a ‘cycling shoe,’” as specifically noted by the Board.

5. Even if the rejections of claims 2-4, 7, 11-14, 16, 18, 19, 23, and 25 stand, which they can not, Applicant respectfully submits that the Examiner has failed to make a prima facie case of obviousness of the enumerated claims. The Board noted that the Examiner has used the “claimed invention as a template to pick and choose among isolated disclosures . . . and then piece those disparate disclosures together in an effort to render [the] claimed invention obvious.” Decision at 6-7. The Examiner’s “new” rejections suffer the same shortcomings. The Examiner has merely applied Anderie *alone* to claims where his rejections based on the combination of Anderie, Dubner, and Krauter were overturned due to lack of motivation to combine the references. *See* Decision at 7-8. Additionally, the Board determined that there was no motivation to apply Nagano or Eisenbach to cure the deficiencies of the combined teachings of Anderie, Dubner, and Krauter, yet the Examiner now simply has combined Anderie with Nagano or Eisenbach where his combinations of Anderie, Dubner, and Krauter, and Nagano or Eisenbach were overturned.⁴ *See* Decision at 9.

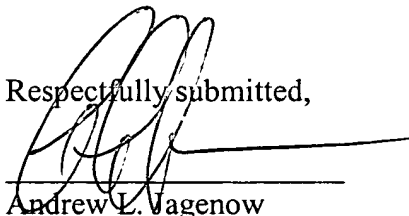
CONCLUSION

Applicant respectfully submits that, in light of the foregoing remarks, the amendments overcome the Board’s rejection, and the new grounds of rejection by the Examiner are procedurally improper. If the new grounds of rejection are deemed procedurally proper, Applicant submits that they are inadequate for the reasons identified in the Decision and above. A favorable action is requested.

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Respectfully submitted,



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⁴ Indeed, paragraphs 5, 6, and 7 in the Office action are merely regurgitations of paragraphs 3, 4, and 7 in the appealed final Office action, with Anderie substituted for the rejected combination of Anderie, Dubner, and Krauter.